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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,399	08/25/2003	Michael L. Boroson	86031RLO	2652

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EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,399

Applicant(s)

BOROSON ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/26/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/26/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 8/26/03 was filed after the mailing date of the filing of the application on 8/25/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Status

Claims 1-17 are pending and are rejected as followed.

Claim Rejections - 35 USC § 112

2. **Claims 1-3, 4-6, 7-9, 10-13, 14-16, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

(1) In claim 1, the preamble calls for "facilitating the design specification and ordering from a manufacturer" but there are no mentioning of "design specification" and "ordering" in the body of the claims.

(2) In claim 1, the phrase "which is desired by a product designer" on line 2 is vague since it's not clear how the product being desired by a product designer has to do with the claim scope?

(3) In claim 1, step (b) is vague since it's not clear to whom the manufacturers providing the information?

(4) In claim 1, In step (c.), it's not clear how the step of "providing suggested design changes" is carried out based on "current manufacturing information received"?

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In other word, after receiving the information, what other steps are involved before the information are used for providing suggestion?

(5) Claim 1, step (d) recites the limitation "services rendered" in line 13. There is insufficient antecedent basis for this limitation in the claim.

(6) In claim 3, the phrases "suggested manufacturers", "delivery information", "display product performance information", or "combinations thereof" are vague and indefinite. For example, what does the phrase "suggested manufactures" really means?

(7) Independent method claim 4 is rejected for similar reasons set forth in independent method claim 1 above.

(8) Dependent method claim 6 is rejected for similar reasons set forth in dependent method claim 3 above.

(9) Independent method claim 7 is rejected for similar reasons set forth in independent method claim 1 above.

(10) Dependent method claim 9 is rejected for similar reasons set forth in dependent method claim 3 above.

(11) Independent method claim 10 is rejected for similar reasons set forth in independent method claim 1 above.

(12) Independent method claim 14 is rejected for similar reasons set forth in independent method claim 1 above.

(13) Independent method claim 17 is rejected for similar reasons set forth in independent method claim 1 above.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 1-3, 4-6, 7-9, 10-13, 14-16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (or AAPA) in view of ANANIAN et al (US Patent 6,922,701).**

As for independent method claim 1, AAPA, as shown in "Background of the Invention", pages 1-3, AAPA discloses a process for transferring information (design specification) from a product designer to product manufacturers comprising the steps of:

(a) the product designer (entity 1st) providing design information for a particular desired display product to product manufacturer (entity 2nd) or transferring of product specification from computer-aided design (CAD) system to CAM (manufacturing) system,

(b) the manufacturer engineer or technician reviewing the design information and make changes as needed to comply the specification information (design changes) in a manufacturing environment. AAPA fails to disclose the sending of the design information and product information to a 3rd entity (service provider) for reviewing and for providing suggested design changes or approval and wherein the 3rd entity receives a payment for reviewing job.

In a similar method for facilitating the design specification and building (manufacturing) from a manufacturer (builder), ANANIAN et al discloses (a) the use of a 3rd entity {Interactive Profile System, Fig. 1 (10)} for **receiving** the design information for particular product (draft plan or scope of work or plan set {see Fig. 1, element (50)}) from entity 1st (designer or client), (b) the 3rd entity (Interactive Profile System, Fig. 1 (10)) also **receiving** manufacturing (building) information for the particular product from the manufacturer (or builder) {see Fig. 1, element 104}, (c.) the 3rd entity then **analyzing** the design information and based upon current information, providing design **changes** {see col. 3, lines 1-8, col. 9, lines 20-67 "*engineering requirements that are specific for a*

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*region, ...**suggested fastening** ... "*}, for the benefits of improving interactions between the 1st and 2nd entities, reducing lengthy and inefficient communications between the 1st and 2nd entities, or making the 2nd entity (builder/manufacturer more efficient and able to focus on the core task) {see col. 3, lines 52-64}. It would have been obvious to modify the teachings of AAPA by using a 3rd entity {(Interactive Profile System, Fig. 1 (10)) as taught by AAPA for one of the benefits cited above.

As for the last step of (d) the 1st entity providing a payment to the 3rd entity for the service provided, making a payment (or paying money) to an entity for a service it provides is well known in the business art for the entity to survive and continue the service by paying its people and operating cost. This well known concept, payment for service, is also taught in col. 11, lines 15-20 wherein services from external database providers in affiliate with the interactive profile system 10 are carried with a fee or fee for service with the affiliation (usage of) with the external databases. Therefore, it would have been obvious to a skilled artisan to modify the teachings of AAPA /ANANIAN et al by making a payment to the 3rd entity for the service rendered for the reasons set forth above. As for the "name calling" or "title" of the 3rd party such as "service provider" to merely reflect "a provider of a service", this is non-essential to the scope of the claimed invention and would have been obvious to a skilled artisan as mere selection of a name to identify a service provided. Moreover, this is fairly taught in ANANIAN et al col. 11, lines 15-18, where the provision of the external database are called as "external database providers" and therefore, the calling of any other provision of service as

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“service provider” would have been obvious as mere applying the same teaching to other similar service to obtain similar results, absent evidence of unexpected results.

As for dep. claim 2 (part of 1 above), which deals with well known input modifying data parameters, i.e. one of manufacturing data such as current cost (or pricing) data, this is fairly taught in ANANIAN et al col. 11, lines 13-15 “*up to data construction material pricing*”.

As for dep. claim 3 (part of 1 above), which deals with well known output modifying data parameters, i.e. one of the suggested information such as suggested product data or manufacturer, this is fairly taught in ANANIAN et al col. 9, lines 40-53 “*engineering related input*”, “*modifies the component*”, “*a suggested fastening*”.

Alternatively, in view of the teachings of different embodiments and modifications within the scope as shown on ANANIAN et al col. 24, lines 53-67, the selection of the specific change or recommendation depends on the specific case, product type, environment, etc., and would have been obvious to a skilled artisan.

As for independent method claim 4, which has similar limitation to claim 1 with a further limitation of step (a) of “over a secure channel”, this is taught in ANANIAN et al col. 15, lines 28-50.

As for dep. claims 5-6 (part of 4 above), which have similar limitations as in dep. claims 2-3 (part of 1), they are rejected for the same reasons set forth above.

As for independent method claim 7, which has similar limitation to claim 1 with a further limitations of step (a) and (b) of “over a secure channel”, this is taught in ANANIAN et al col. 15, lines 28-50.

As for dep. claims 8-9 (part of 7 above), which have similar limitations as in dep. claims 2-3 (part of 1), they are rejected for the same reasons set forth above.

As for independent method claims 10 and 13, which has similar limitation to claim 1 with a further limitations of step (a) and (b) of "over a secure channel" and "including proposed outline specification including form fit and function" in step (a), this is fairly taught in ANANIAN et al col. 9, lines 38-60, and col. 15, lines 28-50.

As for dep. claim 11 (part of 10 above), which deals with well known payment parameter, i.e. an account to be charged for making payment properly, it would have been obvious to a skilled artisan to implement this for making payment properly. Alternatively, Official notice is taken that this item is old and well known in the payment art and it would have been obvious to one of ordinary skill to include this feature because payment can be properly and efficiently made.

As for dep. claim 12 (part of 10 above), which deals with well known payment parameter, wherein a 2nd party instead of the 1st party, both receive service from 3rd party, provides the payment, this is non-essential to the scope of the claimed invention and it would have been obvious for a 2nd party to make the payment for service received if both the 1st and 2nd parties are related or come from the same company.

As for independent method claim 14, which has the same limitation as in claims 7 and 8, it is rejected for the same reason set forth in claims 7 and 8 cited above.

As for dep. claims 15-16 (part of 10 above), which have the same limitations as in dep. claims 11-12, they are rejected for the same reason set forth in claims 11-12 cited above.

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As for independent method claim 17, which has the same limitation as in claims 7 and 8, it is rejected for the same reason set forth in claims 7 and 8 cited above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Article "An IFC Web-based collaborative construction computer environment:WISPER", especially Fig. 1, fairly teaches the scope of the claimed invention. It's cited here for applicant's awareness of potential use in the future if needed to avoid multiple rejections.

2) Article "Development of International Collaborative CAD/CAM", especially Figs. 2 and 4, fairly teaches the scope of the claimed invention. It's cited here for applicant's awareness of potential use in the future if needed to avoid multiple rejections.

No claims are allowed.

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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

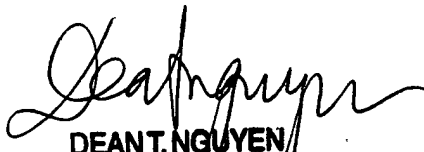
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
February 27, 2006


DEAN T. NGUYEN
PRIMARY EXAMINER